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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,191	06/13/2001	Ippo Aoki	209820US2S	4044

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ALEXANDRIA, VA 22314

EXAMINER

ELAHEE, MD S

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/879,191

Applicant(s)

AOKI ET AL.

Examiner

Md S Elahee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 03 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. This action is responsive to an amendment filed on 04/05/04. Claims 1-26 are pending.

### ***Response to Arguments***

2. Applicant's arguments with respect to claims 1-18 have been fully considered but they are not persuasive.

Regarding claim 1, the Applicant argues on page 13, line 22-page 3, line 3 that Hasegawa does not disclose that a base station offers the desired type of service. The examiner disagrees with this argument. Because, Hasegawa does disclose that a base station offers the desired type of service (fig.6, 7, 20, 31; col.5, lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.14, lines 42-62, col.38, lines 24-44, 59-67, col.39, lines 1-26). Since, the base station is offering announcement service (col.2, lines 24-34). The announcement service provides information such as message type, location code, transmission power level. The base station is also offering telecommunication service. Therefore, the base station offers different types of service. Thus the rejection of the claim in view of Hasegawa remain.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 5, 8, 11 and 14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the

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relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure is non-enabling for claim 1, because, the disclosure does not teach how a system ID is identifying a provider. Claim 1 requires "a system ID identifying a provider" (lines 4, 5). Since the base station is belong to the provider, each base station must generate a system ID to identify the provider. However, no disclosure was provided to teach how the system ID is identifying the provider.

Regarding claims 5, 8, 11 and 14 are rejected for the same reasons as discussed above with respect to claim 1.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-18 are rejected under 35 U.S.C. 102(e) as being anticipated by Hasegawa (U.S. Patent No. 6,493,561).

Regarding claims 1, 5, 8 and 14, Hasegawa teaches means for storing, for each geographical area, identification information (i.e., system IDs), priority data associated with each of the identification information (i.e., system IDs) and information representing types of service each provider offers (fig.6, fig.7; col.2, lines 24-34, col.5, lines 51-67, col.6, lines 1-10, 22-46,

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col.12, lines 53-64, col.39, lines 16-26). (Note: Since, the base station is offering announcement information such as message type, location code, transmission power level as well as telecommunication service, it offers different types of service, which is inherently provided by the provider)

Hasegawa further teaches means for receiving one of the broadcasted identification information (i.e., system IDs) (col.6, lines 22-46, col.12, lines 53-64).

Hasegawa further teaches that first means for connecting (i.e., seizing), based on the stored priority data, one of the base stations operating in a geographical area for which the received identification information (i.e., system ID) is stored to set the apparatus in an idle state (fig.7; col.6, lines 22-46, col.12, lines 53-64, col.38, lines 24-44, 59-67, col.39, lines 1-26).

Hasegawa further teaches means for inputting a request for a desired type of service while the apparatus is in the idle state (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.38, lines 24-28, 59-67, col.39, lines 1-15).

Hasegawa further teaches means, in response to the request, for determining whether the base station offers the type of service in the geographical area based on the information stored for the geographical area (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.38, lines 24-28, 59-67, col.39, lines 1-26).

Hasegawa further teaches reception level measuring unit (i.e., second means) for connecting (i.e., seizing), based on the stored priority data, one of the base stations offering the desired type of service in the geographical area the determining means determines that a base station seized by the first means does not offer the desired type of service (fig.6, 7, 20, 31; col.5,

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lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.14, lines 42-62, col.38, lines 24-44, 59-67, col.39, lines 1-26).

Regarding claims 2, 7, 10 and 18, Hasegawa teaches when the second means failed to seize the base station of the lowest priority, the receiving means newly receives a system ID and the second means seizes one of the base stations operating in a geographical area for which the newly received system ID is stored to set the apparatus in an idle state (col.38, lines 59-67, col.39, lines 1-3, 16-50).

Regarding claims 3, 6, 9 and 13, Hasegawa teaches that the storing means stores frequency data items associated with each of the system IDs, and the second means seizes a base station offering the desired type of service in accordance with the frequency data when the determining means determines that the base station seized by the first means does not offer the desired type of service (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.12, lines 53-64, col.39, lines 16-26).

Regarding claims 4, 12 and 15, Hasegawa teaches means for transmitting the request to the base station seized by the second means (col.5, lines 51-67, col.6, lines 1-10, 22-46, col.39, lines 16-26).

Regarding claim 11 is rejected for the same reasons as discussed above with respect to claims 1 and 2.

Regarding claim 16 is rejected for the same reasons as discussed above with respect to claim 11.

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Regarding claim 17 is rejected for the same reasons as discussed above with respect to claim 1.

***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Md S Elahee whose telephone number is (703)305-4822. The examiner can normally be reached on Mon to Fri from 8:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on (703)305-4895. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.E.

MD SHAFIUL ALAM ELAHEE

June 14, 2004

FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

A handwritten signature in black ink, appearing to be 'Fan Tsang', written over the printed name and title.